

REMARKS

Applicant reviewed the Office Action mailed December 1, 2005, and appreciates the Examiner's comments and indication of allowable subject matter. In view of the foregoing amendments and the following remarks, Applicant respectfully requests allowance of all pending claims, including newly added claims 20-23.

On a preliminary note, Applicant observes that claim 10 as presented in the Preliminary Amendment included a typographic error, as "of" was transcribed as – fo –. While this change was not officially made by way of amendment, claim 10 as it appears in the published application includes this error. To avoid having the claim appear in the incorrect form in any issued patent, claim 10 is represented as new claim 24 without substantive change.

Turning to the substantive issues, the Action rejects independent claim 1 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,121,553 to Boerder; U.K. Patent App. No. 2,170,916 to Bies; and U.S. Patent No. 944,799 to Lytle. However, none of these references anticipate or render obvious the inventions recited in any of the presently pending claims. Upon reviewing the following remarks, it is believed that the Examiner will agree.

Boerder teaches a table saw gauge 20 including a body 22 and a blade 24 pivotally supported on the body. The blade 24 includes a first armature 28 adapted for engagement with the teeth of a table saw blade to determine the height of the blade above the table top. The blade 24 also includes a second armature 30 extending at an angle less than 90° from the table surface. The second armature 30 is adapted to engage the side of the table saw blade to determine the angle between the saw blade and the table top of the saw. The blade 24 further includes a first pointer 32 for cooperation *with a first scale on the body 22 to determine the height of the table saw blade*. The blade 24 also includes a second pointer 34 for cooperation with *a second scale on the body 22 to determine the angle between the table saw blade and the table top*.

Nowhere does Boerder disclose a device wherein a “first information set includes *a set of angles corresponding to angles useable for marking a work piece with an angle for a first type of roofing component cut* and the at least one further information set includes *a set of angles useable for marking a work piece with an angle for at least one other type of roofing component cut*,” as required by claim 1. Instead, it only describes a device with a scale to determine the height of a table saw blade and a scale to determine an angle between the table saw blade and the table top. In other words, the device disclosed in Boerder only includes one height measurement scale and one angle measurement scale, both relating to a table saw. Since the Boerder device clearly lacks two information sets relating to angles and in no way relates to “roofing component cuts,” it fails to anticipate claim 1. *See Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 2 USPQ2d 1051 (Fed. Cir. 1987) (finding that a single prior art reference **must** teach each and every element as set forth in the claim in order to anticipate).

For similar reasons, Bies and Lytle fail to anticipate claims 1-9, 11-19, and 24 as now presented. Bies strictly teaches a “planar body 2” with a “right triangular configuration” and a movable arm 4. Likewise, Lytle only describes a diamond-shaped plate A with a rectangular arm C pivotally attached to the plate A. Neither reference discloses a device having “first and second components” that are “substantially arc-shaped segments” with the “second component pivotally connected for relative rotary movement to the first component,” as required by claim 1. Accordingly, the terms of claim 1 and its progeny are not met with the requisite strict identity necessary to support a valid anticipation rejection.

None of the cited references render the inventions of claims 1-9, 10-19, or 24 obvious, either. Boerder cannot *per se* render the invention of claim 1 obvious, since as noted above it fails to teach or suggest the two information sets relating to angles and “roofing component cuts,” let alone in connection with two pivotally connected arc-shaped segments. *See In re Wilson*, 165 USPQ 494, 496 (CCPA 1970) (finding that “[t]o establish *prima facie*

obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art"). Neither Lytle nor Bies supply the missing teaching of two pivotally connected arc-shaped segments, which facilitates manufacturing and ease of use (since the two components lack corners and can be pivoted to substantially overlap each other, both of which make it easier to carry around the device in one's pocket in a construction environment). Accordingly, their combination does not, and cannot, meet the terms of claim 1.

Furthermore, absolutely no motivation exists to combine Boerder, which again relates solely to a table saw gauge, with any of the other references cited by the Examiner against the claims. Both Lytle and Bies disclose portable/handheld devices that are intended to assist with marking a workpiece, whereas, the device of Boerder is intended for stationary use in measuring a dimension at a saw table. In fact, the edge marked 24, 30 of the Boerder device is shaped specifically to allow contact with a table saw blade (see Figure 11) in use, and the device must be stood on top of the table surface (thus preventing its use for purposes of marking a workpiece). Therefore, a skilled artisan would not consider combining features of the Boerder table saw device with the portable marking devices disclosed in Lytle and Bies. The additional citation to Wagner et al., which relates strictly to color coding, does not supply the necessary missing teaching to make the *prima facie* case of obviousness with respect to claim 1.

Finally, Applicant submits new claims 20-23. Claim 20 is previously presented claim 12 in independent form. Since previously presented claim 12 contained allowable subject matter, as indicated in the Action, Applicant respectfully submits that claim 20 and its dependent claims 21 and 22 should also be allowable. Claim 23 presents a method of marking a roofing component utilizing the device of claim 1. As claim 1 contains allowable subject matter, as discussed above, Applicant respectfully submits that claim 23 should also be allowed.

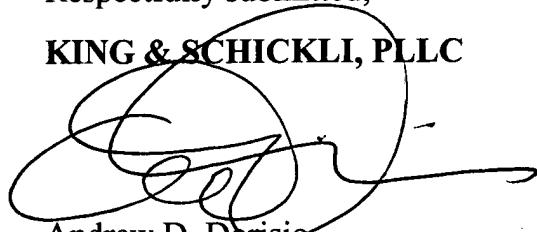
Amendment dated February 24, 2006

Reply to Office Action of December 1, 2005

In view of the foregoing amendments and remarks, Applicant respectfully requests a Notice of Allowance for claims 1-9 and 11-24. If any matters require further attention, the Examiner is requested to contact Applicant's attorney at the telephone number below. The undersigned authorizes the deduction of any necessary fees from Deposit Account No. 11-0978.

Respectfully submitted,

KING & SCHICKLI, PLLC

A handwritten signature in black ink, appearing to read "Andrew D. Dorisio". It is enclosed within a large, roughly circular outline.

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